

FEB 21 2007

AMENDMENT UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2178
PATENT

Application # 10/664,754

Attorney Docket # 2002P15652US01 (1009-039)

REMARKS

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 4-7 and 9 has been amended for at least one reason unrelated to patentability, including at least one of: to address one or more informalities; to explicitly present one or more limitations, phrases, words, terms, and/or elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-20 are now pending in this application. Each of claims 1, 19, and 20 are in independent form.

The Anticipation Rejections

Each of claims 1-20 was rejected as anticipated under 35 U.S.C. 102(b). In support of the rejection, various portions of U.S. Patent No. 5,911,145 ("Arora") were applied. These rejections are respectfully traversed.

A. Legal Standards

1. Express Anticipation Rejections

To establish a *prima facie* case of express anticipation, the "invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim". *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); *See also*,

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MPEP 2131. The single reference must describe the claimed subject matter "with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention". *Crown Operations Int'l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002).

Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (CCPA 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003) ("A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.")

The USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967).

2. Claim Construction

Before criteria for a *prima facie* rejection can be applied, the words of each claim must be interpreted. The Federal Circuit, in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*), *cert. denied*, 2006 U.S. LEXIS 1154, 2006 WL 386393, __ US __, 126 S.Ct. 1174, 163 L.Ed.2d 1141 (2006) has clarified that:

1. "[t]he Patent and Trademark Office ('PTO') determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art'" (*Id.* at 1316);
2. the words of a claim "are generally given their ordinary and customary meaning" (*Id.* at 1312);
3. the ordinary and customary meaning of a claim term is "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application" (*Id.* at 1313);
4. "the person of ordinary skill in the art is deemed to read the claim term not only in the

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context of the particular claim in which the disputed term appears, but **in the context of the entire patent, including the specification**" (*Id.*);

5. even "the context in which a term is used in the asserted claim can be highly instructive" (*Id.* at 1314);
6. "the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, **the inventor's lexicography governs**" (*Id.* at 1316);
7. even "when guidance is not provided in explicit definitional format, **the specification may define claim terms by implication** such that the meaning may be found in or ascertained by a reading of the patent documents" (*Id.* at 1321);
8. an "invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office" (*Id.* at 1317 (*citing Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966))); and
9. the "prosecution history... consists of the complete record of the proceedings before the PTO and **includes the prior art cited during the examination of the patent**" (*Id.* at 1317).

The rules established in *Phillips* apply to *ex parte* examination in the USPTO. *See, In re Kumar*, 418 F.2d 1361 (Fed. Cir. 2005).

B. Analysis

1. Claim Construction

Each of independent claims 1, 18, and 19 states, *inter alia*, "HMI screen nodes". The present Application explicitly defines the claim phrase "HMI screen node", at paragraph 16 of the present application as originally submitted as, "a miniaturized visual representation of an HMI user screen."

The present Application explicitly defines the claim phrase "HMI user screen", at paragraph 11 of the present application as originally submitted as, "a visual display of an HMI renderable via a monitor."

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The present Application explicitly defines the claim phrase "HMI", at paragraph 10 of the present application as originally submitted as (emphasis added), "a human machine interface used for monitoring, programming, and/or controlling automation machines and/or processes. An HMI can, for example, interpret communications from a human operator of an industrial plant to an automated machine controller, and vice versa.

Since these phrases have been clearly and explicitly defined in the specification, those definitions must control examination of each of claims 1-20.

2. Claims 1-20

Each of claims 1, 19, and 20, from one of which each of claims 2-18 ultimately depend, states, *inter alia*, yet the applied portions of Arora do not teach, "HMI screen nodes". Instead, the applied portions of Arora are directed, at least at col. 2, lines 18-21, towards "web pages". Applicant respectfully submits that no evidence has been presented by the present Office Action that would indicate that the "web pages" of Arora teach "HMI screen nodes" as claimed and defined by Applicant.

For at least these reasons, it is respectfully submitted that Arora fails to establish a *prima facie* case of anticipation, and the rejection of each of claims 1, 19, and 20 is unsupported by Arora and should be withdrawn. Also, the rejection of each of claims 2-18, each ultimately depending from independent claim 1, is unsupported by Arora and also should be withdrawn.

C. Next Office Action

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a "new grounds of rejection." Consequently, any Office Action containing such rejection can not properly be made final. See, *In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining "new ground of rejection" and requiring that "when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make

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a showing of unobviousness vis-a-vis such portion of the reference”), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO “has the initial duty of supplying the factual basis for its rejection”). For at least this reason, Applicant respectfully submits that the next Office Action cannot be made final since no *prima facie* rejection of any of claims 1-20 is established by the present Office Action.

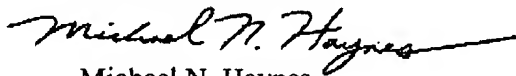
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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Date: 21 February 2007

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